

REMARKS/ARGUMENTS

The office action of September 8, 2006 has been carefully reviewed and these remarks are responsive thereto. Reconsideration and allowance of the instant application are respectfully requested. Claims 2, 5-7, 9, 10, 13, 15, 16 and 21-26 remain in this application. Claims 1, 3, 4, 8, 11, 12, 14, 17, 18 and 20 were previously canceled without prejudice or disclaimer. No new claims have been added.

Claim 6 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants have amended claim 6 to address the informality identified in the action.

Claims 5-7, 9, 10, 13, 15, 16, 19, and 23-26 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. patent no. 6,551,357 B1 to Madduri. Applicants respectfully traverse this rejection.

The action alleges that Madduri discloses all the elements of independent claim 23. As amended, claim 23 includes, among other features, a processor for creating a renderable image having clips, wherein at least one of the clips is a combination of two or more annotations and their associated content, the processor executing instructions including encompassing first content and an associated annotation in a first region, encompassing second content and an associated annotation in a second region, wherein the first and second regions are non-contiguous, and combining the first region and the second region to form one of the clips. To show combining the first region and the second region to form one of the clips, the action relies on col. 7, lines 55-67 of Madduri which describes that markings (annotations) from different users overlap in the displayed document, which causes “the display of color that is a combination of the colors of the overlapping markings.” In contrast, amended claim 23 recites that the first and second regions are non-contiguous. As such, the first content and the associated annotation in the first region are not contiguous with the second content and the associated annotation in the second region. In Madduri however, the combined annotations and content are from overlapping regions. For at least this reason, Madduri fails to teach or suggest all the features of claim 23.

Claims 5-7, and 24-26, which ultimately depend from claim 23, are patentably distinct from Madduri for the same reasons as their ultimate base claim and further in view of the additional advantageous features recited therein. For example, amended claim 24 recites that third content without an associated annotation is located in a third region located between the first and second regions. Such a feature is neither taught nor suggested by Madduri. Also, amended claim 7 calls for storing the annotation and a static image of the first content associated with the annotation, wherein the first content changes over time. Such a feature is absent from Madduri.

In addition, claim 25 call for the annotations being from different documents. To show this feature, the action points to col. 6, lines 44-55. A close reading of Madduri suggests nothing more than one document having multiple associated marking files. Namely, multiple marking files may be superimposed on a single document. Indeed, at col. 6, line 54-55, Madduri states that “the user may concurrently superimpose on electronic media document markings from multiple files”. Notably, there is no suggestion that more than one document is even open, much less annotations are from different documents.

Also, claim 26 calls for the documents to be from different applications. To show this feature, the action points to col. 5, lines 1-16. However, Madduri, at col. 5, lines 8-12 merely states that the document presented by the viewer program “may include text in any text format known in the art, . . . , a format specific to a word processor document (e.g., WordPerfect, Microsoft Word) or any other format known in the art for displaying text.” Namely, Madduri describes that a document presented in the viewer may be from one of several word processing applications. As discussed with respect to claim 25 however, nowhere does Madduri teach or suggest that more than one document is even open. It necessarily follows that annotations from documents in different applications are not combined.

The action contends that Madduri shows all the features of independent claims 9 and 15. As amended claims 9 and 15 each call for receiving at least two sets of an annotation and related content, the at least two sets being from non-contiguous portions of a document or portions of different documents and combining the at least two sets to form a combination consisting of non-contiguous portions of a document or portions of different documents or both. Madduri neither

teaches nor suggests a combination consisting of non-contiguous portions of a document or portions of different documents or both as claimed. Madduri discloses a document with a subset of markings for one user to be combined with the markings of another user on the document for the document as a whole, but Madduri does not form a combination *consisting of non-contiguous portions of the document*. For at least this reason, claims 9 and 15 are patentably distinct from Madduri.

The action alleges that Madduri discloses all the elements of independent claims 13 and 19. To show “storing associations regarding at least two documents from which said annotation originates, wherein selection of said annotation accesses the at least two documents to display said annotation”, the action points to col. 6, lines 26-31 of Madduri. Yet Madduri provides no suggestion that one annotation originates in at least two documents as claimed. Indeed, each markings file corresponds to one document as ostensibly describes in col. 6, lines 30-31. It necessarily follows that selection of a marking file accesses only a single document. For at least these reasons, claims 13 and 19 are patentably distinguishable from Madduri.

Claim 2 stands rejected 35 U.S.C. § 103(a) as being unpatentable over Madduri in view of U.S. patent no. 6,279,014 B1 to Schilit et al. (“Schilit”). Irrespective of whether Madduri and Schilit are properly combinable, their combination does not result in the claim 2 invention. Specifically, Schilit fails to remedy the defects of Madduri described above with respect to claim 23. Namely, Schilit is wholly devoid of a teaching or suggestion of encompassing second content and an associated annotation in a second region, wherein *the first and second regions are non-contiguous*. As such, the combination of Madduri and Schilit, even if proper, does not result in the claim 2 combination of features.

Claims 21 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Madduri in view of U.S. patent no. 5,592,568 to Wilcox et al. (“Wilcox”). Applicants respectfully traverse these rejections.

The action alleges that Madduri shows all the features of independent claim 21 similar to claim 23, but for the bounding boxes. To overcome this deficiency, the action relies on Wilcox.

Amended claim 21 recites that the first and second bounding boxes are non-contiguous. As discussed with respect to claim 23, in Madduri the combined annotations and content are from overlapping regions. While Wilcox discloses combining neighboring bounding boxes, there is no motivation identified in Madduri, Wilcox or otherwise to modify Madduri with Wilcox to combine non-contiguous bounding boxes to form a clip. Indeed, Madduri attempts to address problems associated with multiple users editing a file, and more specifically the same underlying content in the file, by allowing multiple marking files to be superimposed on the same document. That is, multiple marking files may be associated with the same underlying content. As such, the notion of combining non-contiguous bounding boxes does not make sense in this context. In view of the foregoing, claim 21 is patentably distinct from the combination of Madduri and Wilcox and the combination would not have been proper.

Claim 22, which depends from claim 21, is patentable for the same reasons as its base claim, and further in view of the additional advantageous features recited therein.

CONCLUSION

It is believed that no fee is required for this submission. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

All rejections having been addressed, applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same.

Respectfully submitted,

BANNER & WITCOFF, LTD.

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By: /Gary D. Fedorochko/
Gary D. Fedorochko
Registration No. 35,509

1001 G Street, N.W.
Washington, D.C. 20001-4597
Tel: (202) 824-3000
Fax: (202) 824-3001

GDF:lab